



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,646	08/07/2001	Craig M. Janik	5532.P006X	7462

7590

02/17/2004

Archana B. Vittal
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

NGUYEN, JOSEPH D

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 02/17/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,646

Applicant(s)

JANIK, CRAIG M.

Examiner

Joseph D Nguyen

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9-16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis (6,055,566).

Regarding claim 1, Kikinis discloses a method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 2 lines 12-40, col. 7 lines 18-26); and

b) automatically sending the digital data from the computer to a client device using a wireless data transceiver (abstract, fig. 1, col. 2 line 12 thru col. 3 line 6, and col. 5 lines 22-65).

Regarding claim 2, Kikinis further discloses the method of claim 1 further comprising manipulating the digital data on the client device from the computer (#123 fig. 1, col. 2 line 12 thru col. 4 line 31).

Regarding claim 3, Kikinis further discloses the method of claim 2 wherein manipulating the digital data on the client device from the computer includes sending signals to the computer via a remote controller (fig. 1, col. 2 line 12 thru col. 4 line 31, and col. 5 lines 22-65).

Regarding claim 4, Kikinis further discloses the method of claim 1 further comprising manipulating the digital data on the client device from a website (internet) (col. 5 lines 22-65).

Regarding claim 5, Kikinis further discloses the method of claim 1 further comprising manipulating the digital data on the client device from a portable electronic device (wireless device) (col. 5 lines 22-65).

Regarding claim 6, Kikinis further discloses the method of claim 1 further comprising retaining user specified preferences in a database on the computer (col. 3 line 57 thru col. 4 line 22).

Regarding claim 9, Kikinis discloses a machine-readable storage medium (server with memory) tangibly embodying a sequence of instructions executable by the machine to perform a method (abstract, col. 6 lines 5-16), the method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 2 lines 12-40, and col. 7 lines 18-26); and

Art Unit: 2683

b) automatically sending the digital data from the computer to a client device using a wireless data transceiver (abstract, fig. 1, col. 2 line 12 thru col. 3 line 16, and col. 5 lines 22-65).

Regarding claim 10, Kikinis discloses a method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 2 lines 12-40, and col. 7 lines 18-26); and

b) automatically sending the digital data from the computer to a television using a wireless data transceiver (abstract, fig. 1, col. 2 line 12 thru col. 3 line 16, and col. 5 lines 22-65).

Regarding claim 11, Kikinis further discloses the method of claim 10 further comprising converting the digital data to a format capable of being displayed on the television (TV) (col. 2 line 12 thru col. 3 line 43, and col. 6 line 66 thru col. 7 line 17).

Regarding claim 12, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 13, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 14, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 15, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 16, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 19, Kikinis discloses a machine-readable storage medium (server with memory) tangibly embodying a sequence of instructions executable by the machine to perform a method (abstract, col. 6 lines 5-16), the method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 2 lines 12-40, and col. 7 lines 18-26); and

b) automatically sending the digital data from the computer to a television using a wireless data transceiver (abstract, fig. 1, col. 2 line 12 thru col. 3 line 16, and col. 5 lines 22-65).

3. Claims 20-33, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Macrae et al. (6,052,145).

Regarding claim 20, Macrae et al. discloses a method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 4 lines 10-38);

Art Unit: 2683

b) turning on a television at a specified time based on the preferences (fig. 1, col. 4 line 10 thru col. 5 line 34).

c) automatically sending the digital data to the television using a wireless data transceiver (abstract, fig. 1, col. 4 line 10 thru col. 6 line 62).

Regarding claim 21, Macrae et al. further discloses the method of claim 20 further comprising shutting the television off (switch off) for a predetermined period of time in response to a remote controller sending a signal to the computer (col. 4 line 66 thru col. 5 line 34).

Regarding claim 22, Macrae et al. further discloses the method of claim 21 wherein shutting the television off includes stopping the sending of digital data to the television (col. 4 line 66 thru col. 5 line 34).

Regarding claim 23, Macrae et al. further discloses the method of claim 20 further comprising converting the digital data to a format capable of being displayed on the television (abstract).

Regarding claim 24, Macrae et al. further discloses the method of claim 20 further comprising manipulating the digital data on the television (abstract, fig. 13, 19-20, col. 2 lines 7-46).

Regarding claim 25, Macrae et al. further discloses the method of claim 20 further comprising storing user specified preferences in a database on the computer (abstract, fig. 3, col. 2 lines 7-46).

Regarding claim 26, Macrae et al. discloses a method comprising:

- a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 4 lines 10-38);
- b) turning on an audio playback device at a specified time based on the preferences (fig. 1, col. 4 line 10 thru col. 5 line 34); and
- c) automatically sending the digital data to the audio playback device using a wireless data transceiver (abstract, fig. 1, col. 4 line 10 thru col. 6 line 62).

Regarding claim 27, this claim is rejected for the same reason as set forth in claim 21.

Regarding claim 28, this claim is rejected for the same reason as set forth in claim 22.

Regarding claim 29, this claim is rejected for the same reason as set forth in claim 23.

Regarding claim 30, this claim is rejected for the same reason as set forth in claim 24.

Regarding claim 31, this claim is rejected for the same reason as set forth in claim 25.

Regarding claim 32, Macrae et al. discloses a method comprising:

Art Unit: 2683

a) determining a plurality of preferences based on primary digital data sent to a television (abstract, fig. 1);

b) automatically searching for related ancillary digital data on a wide area network based on the preferences (abstract, fig. 1, col. 4 lines 10-38);

c) receiving the related ancillary digital data to a computer (abstract, fig. 1, col. 4 lines 10-63); and

d) automatically sending the related ancillary digital data to a client device using a wireless data transceiver (abstract, fig. 1, col. 4 line 10 thru col. 6 line 62).

Regarding claim 33, this claim is rejected for the same reason as set forth in claim 25.

Regarding claim 35, this claim is rejected for the same reason as set forth in claim 24.

Regarding claim 36, Macrae et al. further discloses the method of claim 32 further comprising obtaining new ancillary digital content in response to changing the primary content on the television (when the channel is changed on TV, which means the system has to obtain the new ancillary digital content in response to changing the primary content on the television) (fig. 24-28, col. 4 line 65 thru col. 5 line 34, and col. 17 line 21 thru col. 18 line 55).

Art Unit: 2683

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (6,055,566) in view of Evans et al. (6,650,889).

Regarding claim 7, Kikinis further discloses the method of claim 1 of web access. However, Kikinis does not specifically disclose tagging digital content to aggregate a record of that content on a tag aggregation webpage.

Evan et al. teaches tagging digital content to aggregate a record of that content on a tag aggregation webpage (abstract, col. 5 lines 1-30). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kikinis system with the teaching of Evan et al. of tagging digital content to aggregate a record on webpage in order to transmit the webpage back in HTML format to the client device when client device interacts with webpage.

Regarding claim 17, this claim is rejected for the same reason as set forth in claim 7.

6. Claims 8, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (6,055,566) in view of Macrae et al. (6,052,145).

Regarding claim 8, Kikinis further discloses the method of claim 1 further comprising the client device. However, Kikinis does not specifically disclose identifying the client device by a specified serial number.

Macrae et al. teaches identifying the client device by a specified serial number (col. 5 lines 35-61, and col. 19 lines 9-34). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kikinis system with the teaching of Macrae et al. of identifying the client device by a specified serial number in order to transfer the data to the correct subscriber and to bill the customer for the service.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 8.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Macrae et al. (6,052,145) in view of Evans et al. (6,650,889).

Regarding claim 34, Macrae et al. further discloses the method of claim 32 further comprising tagging the ancillary digital content to aggregate a record of that content (col. 12 lines 45-52). However, Macrae et al. does not specifically disclose tagging digital content to aggregate a record of that content on a tag aggregation webpage.

Evan et al. teaches tagging digital content to aggregate a record of that content on a tag aggregation webpage (abstract, col. 5 lines 1-30). Therefore, it would have

Art Unit: 2683

been obvious to one skilled in the art at the time the invention was made to modify Macrae et al. system with the teaching of Evan et al. of tagging digital content to aggregate a record on webpage in order to transmit the webpage back in HTML format to the client device when the client device interacts with webpage.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label
"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA. Sixth floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Nguyen whose telephone number is (703) 605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

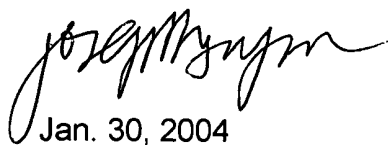
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers

Art Unit: 2683


for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph Nguyen



Jan. 30, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600